

Reply to Office Action
Serial Number 10/692,967
Customer No.: 33354

REMARKS

A. Status of Claims

Claims 1-20 were previously cancelled. Claims 21-40 were previously added and entered by the Examiner and are pending. Claim 40 is currently amended.

B. § 102 Rejections Citing Dobson

The Examiner has rejected claims 31, 32, 36 and 37 under 35 USC §102(b) as being anticipated by U.S. Patent No. 4,666,129 to Dobson (Dobson). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2nd 1051 at 1053 (Fed. Cir.1987).

Dobson does not disclose a planar barrier that is operable in the plane as claimed by Applicants. This claim limitation of a planar barrier that is operable in a plane appears to be the main point of disagreement between the Examiner and Applicants.

The Examiner states that Fig. 8 in Dobson shows a planar, accordion barrier sheet. The Examiner goes on to state that the planar, accordion barrier sheet is operable in the plane. Applicants respectfully disagree with the Examiner on this point. Fig. 8 merely shows "a view of a portion of one face of a barrier constructed in the manner shown in Fig. 7." See column 3,

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lines 66-68. Emphasis added. The barrier is three-dimensional. See Figs. 5, 7, and 9. Therefore, because Fig. 8 only shows one portion (the face) of the barrier, it only shows a single part of a three-dimensional barrier and does not show a planar barrier itself. Stating that Fig. 8 shows a planar barrier when it only really shows a portion of the barrier is akin to stating that a picture that shows a tire shows an entire car. Simply put, Dobson doesn't disclose a planar barrier that is operable in a plane as claimed by Applicants.

Applicants remind the Examiner that the claims as written recite a planar barrier that moves within the same plane as defined by the barrier. The limitation set forth in claim 31 reading "wherein the planar, accordion barrier sheet is operable in the plane" (emphasis added) is meant to capture the aspect of Applicants' invention whereby the planar barrier operates in the same plane defined by the barrier, a feature not disclosed by Dobson because Dobson is three-dimensional. As such, claim 31 as currently written is believed to not be anticipated by Dobson and the Examiner is respectfully requested to withdraw this rejection of claim 31. The Examiner is also requested to withdraw the rejection of dependent claims 32, 36, and 37 based on their dependency on claim 31.

While Applicants' believe that claim 31 and its dependencies are allowable as presently written, the Examiner is requested to call Damon Ashcraft or note in the next office action if there are any claim amendments that he believes would place claim 31 and its dependencies in even a better form for allowance per MPEP §707.07(j) II. See MPEP §707.07(j) II directing

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that an Examiner indicate if certain claim limitations should be added to a claim if Applicant has disclosed allowable subject matter but not properly claimed the allowable subject matter.

B. § 102 Rejections Citing Catalano

The Examiner has rejected claims 21-24, 26-35 and 38-40 under 35 USC §102(b) as being anticipated by U.S. Patent No. 2,990,880 to Catalano, et al. (Catalano). Again, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc.*, 2 USPQ2d at 1053. The Board of Appeals and Interferences has also stated that "anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product." *Ex parte Standish*, 10 USPQ2d 1454, 1457, (PTO Bd. Pat. App. & Int'f 1989).

Catalano discloses a folding gate comprising a series of strips connected together by rivets. Catalano discloses that the gate is placed on either the exterior or interior of a window or doorway to prevent intruders from entering a building. When the gate is expanded, a mesh is formed that is comprised of apertures defined by the various strips.

Catalano does not disclose that the gate has any type of cutters such as razors or barbs as claimed in the present invention. Applicants have considered the Examiner's assertion that the edge flanges could be capable of cutting an intruder and respectfully disagree with the Examiner. Even

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assuming, *arguendo*, that that the edge flanges could cut an intruder, Applicants still believe that the claimed invention is novel over Catalano.

Applicants and Applicants' representative have reviewed both the specification and drawings (specifically Fig. 9) in Catalano and cannot find any support for the Examiner's contention that the edge flanges could cut an intruder. Neither Fig. 9 nor the specification disclose that the edge flanges are sharp or have any type of cutters that would be capable of cutting an intruder as the Examiner suggests. Thus, it appears that the Examiner is hypothesizing based on his viewing of Fig. 9 that the edge flanges are sharp enough to cut an intruder. This type of reasoning is the exact type of "conjecture" relates to a non-disclosed characteristic of prior art that the Board of Appeals and Interferences forbid in *Ex parte Standish*.

In *Standish*, the examiner rejected a claim on the rationale that even though a claimed element was not expressly cited in the specification, that the figures of the reference indicated that the device disclosed in the reference could possibly include the claimed element. *Ex part Standish* at 1455-1456. The Board of Appeals rejected the examiner's argument citing that it was nothing more than mere conjecture on the Examiner's part as to a possible characteristic of the device that wasn't actually supported by the reference. *Id.* The present case is similar to the situation in the *Standish* case as the Examiner appears to be hypothesizing (based on Fig. 9) that the edge flanges could be sharp without any support within Catalano for this conclusion. Since the Board of Appeals and Interferences explicitly forbids this type of

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conjecture in maintaining anticipation rejections, this rejection appears improper and should be withdrawn.

If Applicants and their representatives have overlooked the section of Catalano that discloses edge flanges capable of cutting an intruder, the Examiner is asked to identify the specific location (and any figures) in Catalano that contain such a disclosure so that this reference can be properly addressed.

Even assuming, *arguendo*, that Catalano discloses edge flanges capable of cutting an intruder, it still fails to anticipate the present invention. Independent claims 21 and 31 include the phrase "a plurality of strips with cutters." There are two elements contained within this phrase, 1) "a plurality of strips" and 2) "cutters." Therefore, in order to anticipate the claims, Catalano must disclose a device with "a plurality of strips" and that the strips have "cutters." Assuming, *arguendo*, that Catalano disclosed edge flanges that were sharp enough to cut an intruder it would not anticipate the present invention as claimed. The edge flanges may be analogous to the strips claimed in the present invention. But, Applicants aren't claiming that the strips are sharp or are cutters themselves, Applicants are claiming that the invention has both strips and cutters. As such, a gate such as the one disclosed by Catalano with sharp end flanges would lack the separate "cutters" as claimed in claims 21 and 31.

Even though Applicants believe that all the claims as written are not anticipated by Catalano, they have amended claim 40 to even further

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distinguish claim 40 from Catalano. Specifically, claim 40 has been amended to recite that the cutters are a plurality of razors, that the planar barrier is located between the interior and exterior side of the frame, and that the glass sheets are on both the front and back side of the planar barrier¹. None of these additional claim limitations is disclosed by Catalano and claim 40 is not anticipated by Catalano.

Therefore, the Examiner is respectfully requested to withdraw this anticipatory rejection of independent claims 21, 31, and 40. The Examiner is also requested to withdraw this anticipation rejection of dependent claims 22-24, 26-30, 32-35, 38, and 39 based on their dependency on allowable base claims.

C. § 103 Rejections Citing Catalano

The Examiner has rejected claim 25 under 35 USC §103(a) as being obvious in light of Catalano. Specifically, the Examiner argues that substituting plastic for the claimed limitation of a glass barrier sheet would be obvious as plastic is a known material suitable for Applicants' intended use.

Claim 25 depends from claim 23 that depends from claim 21. As discussed at length above, claim 21 is believed to be allowable as written and claim 25 should also be allowable based on its dependency on claim 21. The Examiner is respectfully requested to withdraw this rejection as well.

¹ No new matter is added by these amendments. Please see Fig. 6 showing razors, and Fig. 5 showing the planar barrier located between the interior and exterior portion of the frame and surrounded by glass on both the front and rear sides.

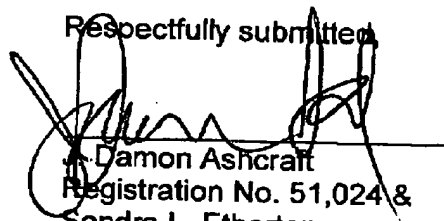
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CONCLUSION

Applicants respectfully submit that all rejections are moot and that the new claims are patentable as discussed during the interview. Applicants respectfully request that the Examiner allow the application to proceed to allowance. If the Examiner has any questions or suggestions to place the application in even a better condition for allowance, he is requested to call Damon Ashcraft at 602-681-3331.

9/23/05
Dated

Respectfully submitted,


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